

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-48 remain pending. Claims 1, 6, 11, 13, 15, 17, 19, 21, 23 and 26 are independent.

In this Reply, claims 6, 13, 17 and 19 are amended merely to address clerical issues. The scope of the claims is not affected by the amendments.

§ 103 REJECTION – MAYLE, GIANNINI, HO-KA-GO

Claims 1, 5-6, 10-48 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mayle et al. (USP 6,542,936) in view of Giannini et al. (USP 7,062,454), and in further view of “Ho-Ka-Go! English Homepage” (Nippon Telegraph and Telephone Corporation, pages 1-5, last updated 3/26/1998). Applicant respectfully traverses.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142*. One requirement to establish *prima facie case* of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, the combination of Mayle, Giannini and Ho-Ka-Go cannot teach all features of the claimed invention. For example, independent claim 1 recites, in part “generating a catalog of the templates each having the

user image therein. Contrary to the Examiner's allegation, Mayle cannot teach or suggest this feature.

Mayle is directed toward a system and method for creation of electronic postcards. As illustrated in Figures 6-17, Mayle discloses that the electronic postcards are generated and sent to various individuals as the user chooses. As illustrated in Figure 4, the generated electronic postcards include static images 401 to 406 and generated images 407 through 409. The steps to generate the finalized electronic postcard are illustrated in Figures 6-17. Figure 6 illustrates a blank electronic postcard 600 which shows both the front 601 and the back 602 of the postcards 600 on one screen. The user customizes the postcard by clicking on tabs 603 to 607 that surround the front 601 and back 602 of electronic postcard. The tabs 603 to 607 correspond to the different parts of the postcard that the user can fill in including sender's name and email address 606, recipient's name and email address 607, message to the recipient 605, a user selected photo areas 603, and a photo caption 604. When the user clicks a tab, a new webpage appears that contains a form with the input fields for the selected part of the card. *See Mayle, col. 8, lines 11-34.*

For example, if the user chooses tab 605 to enter the message to the recipient, the user is prompted to input the message as illustrated in Figures 7 and 8. As another example, if the user wishes to insert a photograph by

clicking on the tab 603, the user is prompted to select the image as illustrated in Figures 9 and 10.

In summary, the final electronic postcard is generated from a blank postcard (i.e. a template) allowing the user to customize individual areas of the blank postcard.

In the Final Office Action, the Examiner alleges that the series of input screens associated with the clickable tabs is interpreted as the plurality of template as recited. However, as demonstrated above, Mayle only discloses a single template, that is the electronic postcard template, displayed over a series of different screens. Mayle cannot teach or suggest the catalog of templates as recited.

Furthermore, claim 1 recites, "wherein each template is unique in its combination of customizable areas within the catalog." Mayle cannot teach or suggest this feature since the blank electronic postcard 600 as disclosed in Mayle has its customizable areas fixed. Thus, Mayle actually teaches away from the feature of wherein each template is unique in its combination of customizable areas.

Neither Giannini nor Ho-Ka-Go is relied upon to correct for at least the above noted deficiencies of Mayle. Indeed, to the extent that Mayle actually teaches away from the feature as recited in claim 1, then by definition, Mayle cannot be combined with other references to reject claim 1. For at least the

above stated reasons, independent claim 1 is distinguishable over the combination of Mayle, Giannini and Ho-Ka-Go.

Independent claim 11 recites, in part “catalog generating means for generating a catalog of the templates by inserting the user image in the image insertion area of each of the templates” and “wherein each template is unique in its combination of customizable areas within the catalog.” It is demonstrated above that these features are not taught or suggested in the combination of Mayle, Giannini and Ho-Ka-Go. Accordingly, claim 11 is distinguishable over same combination of references.

Independent claim 15 recites, in part “inserting the user image in the image insertion area of each of the templates and generating a catalog of the templates each having the user image therein” and “wherein each template is unique in its combination of customizable areas within the catalog.” It is demonstrated that such features are not taught or suggested in the combination of references, Mayle, Giannini and Ho-Ka-Go. Accordingly, independent claim 15 is distinguishable over the same combination of references.

Independent claim 21 recites, in part “generating a catalog of the plurality of templates of the various designs each having the user image therein” and “wherein each template of the catalog is unique in its combination of customizable areas within the catalog.” As demonstrated above, the combination of Mayle, Giannini and Ho-Ka-Go cannot teach or suggest these

features. Accordingly, independent claim 21 is distinguishable over the same combination of references.

Independent claim 23 recites, in part “generating a catalog of a plurality of image inserted templates by inserting the image in to the respective image insertion areas of the plurality of templates” and “wherein each template is unique in its combination of customizable areas including an image insertion area.” As demonstrated above, the combination of Mayle, Giannini and Ho-Ka-Go cannot teach or suggest these features. Accordingly, independent claim 23 is distinguishable over the same combination.

Regarding claim 6, the Examiner alleges that claim 6 incorporates substantially similar subject matter as claimed in claim 1, and simply rejects the claim along the same rationale as applied in claim 1. However, contrary to the Examiner’s allegation, the scope of claims 1 and 6 are different. In claim 1, a catalog of the templates is generated by inserting a user image into a plurality of templates, whereas in claim 6, the catalog of templates are generated by inserting a plurality of images into a template. Thus, claim 6 cannot be rejected along the same rationale as claim 1.

Moreover, claim 6 recites, in part “wherein each template of the catalog has a different user image inserted therein from other templates of the catalog.” In contrast, in Figures 6-17 of Mayle, the same photo is inserted into the photo areas 603. This is logical since Figures 6-17 of Mayle is actually a single template, and not a plurality of templates as alleged by the Examiner.

Giannini and Ho-Ka-Go, individually or in combination, cannot be relied upon to correct for at least the above noted deficiencies of Mayle. Accordingly, independent claim 6 is distinguishable over the combination of Mayle, Giannini, and Ho-Ka-Go.

Independent claim 13 recites, in part “catalog generating means for generating templates having the user images therein by inserting the respective user images in the image insertion area of the template” and “wherein each template of the catalog has a different user image inserted therein from other templates of the catalog.” As demonstrated above, the combination of Mayle, Giannini and Ho-Ka-Go cannot teach or suggest these features. Accordingly, claim 13 is distinguishable over the same combination of references.

Independent claim 17 recites, in part “generating templates having the user images therein by inserting the respective user images in the image insertion area of the template while generating a catalog of the templates having the user images” and “wherein each template of the catalog has a different user image inserted therein from other templates of the catalog.” As demonstrated above, the combination of Mayle, Giannini and Ho-Ka-Go cannot teach or suggest these features. Accordingly, claim 17 is distinguishable over the same combination of references.

Independent claim 19 recites, in part “catalog generating means for generating a plurality of templates of a single design based on the selected template having the user images therein by inserting the respective user

images in an image insertion area in each of the plurality of templates of the single design and for generating a catalog of the plurality of templates of the single design having the user images” and “wherein each template of the catalog has a different user image inserted therein from other templates of the catalog.” It is demonstrated above that the combination of Mayle, Giannini and Ho-Ka-Go cannot teach or suggest these features. Accordingly, claim 19 is distinguishable over the same combination of references.

Claim 26 recites, in part “generating a catalog of a plurality of image inserted templates based on the template, wherein each template of the plurality of image inserted templates includes an image inserted from the plurality of images different from other templates of the plurality of image inserted templates.” It is demonstrated above that the combination of Mayle, Giannini and Ho-Ka-Go cannot teach or suggest this feature. Accordingly, claim 26 is over the same combination of references.

Claims 5, 10, 12, 14, 16, 18, 20, 22, 24-25 and 28-48 depend from independent claims 1, 6, 11, 13, 15, 17, 19, 21, 23 or 26, directly or indirectly. Accordingly, these dependent claims are also distinguishable over the combination of Mayle, Giannini and Ho-Ka-Go for at least due to their dependencies from independent claims.

Applicant respectfully requests that the rejection of claims 1, 5-6 and 10-48 based on Mayle, Giannini and Ho-Ka-Go be withdrawn.

§ 103 REJECTION – MAYLE, GIANNINI, HO-KA-GO, MANOLIS

Claims 2-4 and 7-9 stand rejected under 35 U.S.C 103(a) as allegedly being unpatentable over Mayle, Giannini, Ho-Ka-Go and in further view of Manolis et al. (USP 6,583,799). Applicant respectfully traverses.

It is demonstrated above that claims 1 and 6 are distinguishable over Mayle, Giannini and Ho-Ka-Go. Manolis is not relied upon to correct for at least the above noted deficiencies of Mayle, Giannini and Ho-Ka-Go. Therefore, claims 1 and 6 are distinguishable over the combination of Mayle, Giannini, Ho-Ka-Go and Manolis. Accordingly, claims 2-4 and 7-9 are also distinguishable over Mayle, Giannini, Ho-Ka-Go and Manolis.

Further, modifying Mayle with the teachings of Manolis as the Examiner suggest renders Mayle unsatisfactory for its intended purpose. More specifically, the Examiner alleges that Mayle maybe modified to include thumbnail images in the electronic postcard of Mayle. As anyone of ordinary skill would realize, the quality of the thumbnail image would be entirely unsatisfactory for the electronic postcard type of application. Thus, by definition, Manolis cannot be combined with Mayle as the Examiner alleges.

For at least the above stated reasons, applicant respectfully request that the rejection of claims 2-4 and 7-9 based on Mayle, Giannini, Ho-Ka-Go and Manolis be withdrawn.

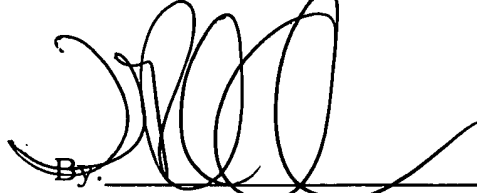
CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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A large, stylized handwritten signature in black ink, appearing to read 'D. Anderson', is written over a horizontal line.

By.

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